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PD

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/391,861 09/07/99 THOMASON

A 99.371

HM22/0127  
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EXAMINER

STROUP, C

ART UNIT	PAPER NUMBER
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1633

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DATE MAILED:

01/27/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.

09/391,681

Applicant(s)

Th mason et al

Examiner

Stroup, Carri

Group Art Unit

1633



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-38 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-38 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, 7-13, and 36, drawn to nucleotides, methods of making and methods of use, classified in class 435, subclass 320.1.
- II. Claim 6, 12, 14-16, 22-32, 34, and 35, drawn to polypeptides, compositions, and methods of use, classified in class 514, subclass 2.
- III. Claims 17-19, 21, and 32, drawn to antibodies, methods of making, and methods of use, classified in class 435, subclass 7.1.
- IV. Claim 33, drawn to a implantable device for sustained release of a protein, classified in class 424, subclass 424.
- V. Claims 37 and 38, drawn to a transgenic animal and methods of use, classified in class 800, subclass 8.

Applicant is advised that where a single claim encompasses more than one invention as defined above, upon election of an invention for examination, said claim will only be examined to the extent that it reads upon the elected invention.

2. The inventions are distinct, each from the other because of the following reasons:

The inventions of groups I-V are drawn to materially different physical and chemical properties, structures, and utilities. For example, the invention of group I is drawn to a polynucleotide of SEQ ID NO: 1 or 3, which has different characteristics and functions compared to the inventions of groups II-V, which are drawn to polypeptides,

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antibodies, drug delivery devices, and transgenic animals. Likewise, the structure, function, and utilities of a polypeptides, antibodies, transgenics, and devices.

3. The inventions of groups I-III and V are drawn to materially different methods. For example, the methods of use of the invention of group I is drawn to a method of treatment via gene therapy, that of group II is drawn to a method of treatment via peptide therapy, that of group III to methods of identifying and quantifying proteins via the use of antibodies, and that of group V to use of a transgenic animal to test the effect of compounds on the level of FGF activity.

4. The inventions of groups I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the polypeptide of group I can be made by chemical synthesis.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent classifications, recognized divergent subject matter and further because the searches required for the different inventions are not coextensive, restriction for examination purposes as indicated is proper.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carrie Stroup whose telephone number is (703) 306-5439. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader, can be reached at (703) 308-0447. The fax phone number for this Group is (703) 308-8724.

Carrie Stroup

  
JOHN L. LeGUYADER  
PRIMARY EXAMINER  
GROUP 1800  
1600